

Appl. No. 09/890,919
Atty. Docket No. CM2034
Amtd. dated 08/01/2003
Reply to Office Action of 03/13/2003
Customer No. 27752

REMARKS

Claims 1-13 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has been amended to change "C₁₀-C₁₆" to "C₈-C₂₄". Support for the amendment is found at page 21, line 25 of the specification

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested

Rejections Under 35 USC 112, First Paragraph

Objection (i)

The Office Action states: The phrase 0.01% to about 1.0% of C₁₀ to C₁₆ mono, di- and tri- acyl sugar esters in claim 1 is new and was not recited in the original disclosure. Applicants respectfully traverse this assertion. Page 21, lines 19-30 and page 22, line 1 of the instant specification state:

"Preferably the compositions herein comprise non-ionic amphiphilic surfactants at a level of from about 0.01 % to about 4%, preferably from about 0.05% to about 3%, and more preferably from about 0.08% to about 2%. Preferred classes of non-ionic amphiphilic surfactants suitable herein and their properties are disclosed in WO98/22085, incorporated herein by reference. Preferred herein are the mono-, di- and tri-acyl sugar esters and mixtures thereof wherein the acyl substituents contain from about 8 to about 24, preferably from about 8 to about 20 carbon atoms and 0,1 or 2 unsaturated moieties and polyethylene glycol derivatives. High preferred herein is a fatty acid ester blend based on a mixture of sorbitan or sorbitol fatty acid ester and sucrose fatty acid ester, the fatty acid in each instance being preferably C₈-C₂₄, more preferably C₁₀-C₂₀. The preferred fatty acid ester emulsifier from the viewpoint of moisturisation is a blend of sorbitan or sorbitol C₁₆-C₂₀ fatty acid ester with sucrose C₁₀-C₁₆ fatty acid ester, especially sorbitan stearate and sucrose cocoate." (bolding mine)

While the percentage range of sugar esters disclosed is broader than 0.01% to 1.0%, as currently claimed, the claimed percentages are clearly contained in the disclosed range. The U.S.

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Court of Customs and Patent Appeals has stated "The invention claimed does not have to be described *in ipsis verbis* in order to satisfy the description requirement of 35 U.S.C.S. § 112. The burden of showing that the claimed invention is not described in the specification rests on the Patent and Trademark Office (PTO) in the first instance, and it is upon to the PTO to give reasons why a description not *in ipsis verbis* is insufficient. In re Wertheim, 541 F.2d 257, 1976 CCPA Lexis 134, 191 U.S.P.Q. (BNA) 90 .

The use of mono-, di- and tri-acyl sugar esters, as amphiphilic surfactants, is clearly disclosed at page 21, line 24. While the 10 to 16 carbon range is clearly included within the 8 to 24 carbon range, disclosed at page 21, line 25, claim 1 has now been amended to reflect the exact wording of the specification with regard to the carbon range. Additionally, the Examples of the instant compositions all comprise the amphiphilic surfactant, Arlatone 2121, at 1.0%. Considering that the currently claimed range lies inside the disclosed range and clearly reflects the amounts used in the Examples, Applicants assert that written description of the invention would enable one skilled in the art to make and use the matter of claims 1-13.

Objection (ii)

The Office Action states: "The phrase "left on the skin" in claim 13 is vague and indefinite, as it is confusing. Are not all cosmetic compositions for skin care left on the skin?"

Applicants assert that the phrase "left on the skin" is not vague and indefinite, nor confusing. Both those of skill in the art and consumers of skin care products are aware that many skin care products (including that of the Shana'a patent which is cited in this Office Action) are made to be removed from the skin. Skin care products used for washing are rinsed from the skin. Skin care masks and some creams are rinsed or wiped from the skin following use.

Rejection Under 35 USC 103(a) Over Shana'a (WO 94/03150)]

Claims 1-9 have been rejected under 35 USC 103(a) as being unpatentable over Shana'a.

Shana'a does not teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03). Shana'a discloses mild washing compositions having an oily skin benefit and comprising (a) an oily component, (b) at least one non-ionic sugar-based surfactant, said surfactant being present in weight excess over the oily component, and (c) a water-soluble cationic polymer.(bolding mine)

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Those of skill in the art would understand that the Shana'a composition, while used in skin care, is a washing composition. Personal cleansing (washing) compositions have traditionally contained high levels of surfactant. The Shana'a compositions, as shown in the examples, do contain high levels of surfactant. In spite of the 1-50% surfactant range recited in the citation, all cited examples contain at least 20% surfactant. The compositions of the instant application, however, contain very low levels of surfactant, i.e., 1.0% or less.

Even more significant, the level of oily component is stated to be from 1 to 50% of the Shana'a composition and the nonionic sugar based surfactant must be present in weight excess over the oily component. Therefore, by definition, the cited compositions must contain more than 1% non-ionic surfactant.

Further, the cited compositions are said to be foaming compositions. The citation states at page 2 lines 5-9 "It is known that oils have a depressant effect on foam." At page 2, lines 17-22, it states: "...having regard to the poor foaming properties of nonionic surfactants and anti-foam effects of oils, it can be seen that the preparation of a foaming, mild washing composition capable of depositing an oil on the skin presents considerable technical difficulties." These statements would motivate one of skill in the art to include, if anything, higher levels of surfactant rather than lower levels.

Therefore there are two reasons why, it would not have been obvious for one of skill in the art to exemplify a composition of Shana'a by using 1% of alkyl polysaccharide. First, if 1% oily component was used, the composition would, by Shana'a's definition, comprise greater than 1% sugar based nonionic surfactant. Secondly, Shana'a teaches away from the inclusion of small amounts of surfactant.

Rejection Under 35 USC 103(a) Over Shana'a (WO 94/03150)], and further in view of The Handbook of Cosmetic Science and Technology

Claims 10-13 are rejected under 103(a) as being unpatentable over Shana'a as applied to claims 1-9 above and The Handbook of Cosmetic Science and Technology. The Office Action states that the Handbook teaches that anionic surfactants produce a desirable combination of rich foam and excellent mildness. However, Shana'a states: "In addition, it is important that washing compositions are mild to the skin. While nonionic surfactants are known to be particularly mild, especially as compared with anionic and cationic surfactants..." Therefore, if one of skill in the art were searching for mild surfactants, he or she would not choose an anionic based on a reading of Shana'a. Also, instant claim 9, which introduces the additional surfactants to the instant claims, still limits the percentage to less than 2%, resulting in a maximum of 3% surfactant. All examples

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of Shana'a contain at least 20% surfactant. There is no motivation in Shana'a for one of skill in the art to add anionic surfactants to its compositions. The matter of claims 10-13 is not obvious in light of this rejection.

Conclusion

In light of the above amendments and remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC 112 and 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-13.

Respectfully submitted,

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August 1, 2003

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